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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/349,737 07/08/99 SHACKLETT

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REED SMITH SHAW & MCCLAY LLP
2500 ONE LIBERTY PLACE
1650 MARKET STREET
PHILADELPHIA PA 19103-7301

EXAMINER

PRATT, C

ART UNIT

PAPER NUMBER

1771

DATE MAILED:

04/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/349,737

Applicant(s)

SHACKLETT ET AL.

Examiner

Christopher C. Pratt

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1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-19 and 43-59, drawn to a pad, classified in class 442, subclass 65.
 - II. Claims 20-34, drawn to a method of making a printed pad, classified in class 427, subclass various.
 - III. Claims 35-42, drawn to a system, classified in class 83, subclass 78
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another process comprising applying the ink by hand or screen printing.
4. Inventions I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus can be used to make another product comprising a woven or knitted fabric.

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5. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects as group II produces a printed fabric and group III produces a cut fabric.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. This application contains claims directed to the following patentably distinct species of the claimed invention: Group I contains patentably distinct species I (claims 1-19 and 58), species II (claims 43-57), and species II (claim 59).
non-obvious

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. During a telephone conversation with Tom McWilliams on 4/18/01 a provisional election was made with traverse to prosecute the invention of group I, claims 1-19 and 58. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-57 and 59 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10-12 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10-12 and 17 are indefinite because they attempt to define particular dyes by standards, which may change in the future. This rejection could be overcome by replacing these claims with the actual dyes that conform to each standard.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-19 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over either McFarland et al (6096412) or Schleinz et al (5458590) in view of Krzysik et al (5601871).

Both McFarland and Schleinz are concerned with the creation of printing ink on an absorbent nonwoven material. Neither reference specifically states the level of absorbency of said nonwovens, however it is the examiner's position that both are capable of absorbing at least about 1.5 times the weight of the material. McFarland

teaches the creation of a paper towel (col. 22, lines 30-35) and Schleinz teaches the creation of a backsheet for an absorbent diaper (col. 6, lines 60-65 and col. 8, lines 1-6). Both applications require a high rate of absorbency, therefore if they do not inherently have applicant's claimed absorbency it would have been obvious to the skilled artisan to increase their absorbency in order to make them more efficient in their respective applications. Both references teach printing ink on at least one side of the web.

Krzysik is concerned with the creation of an absorbent nonwoven web having materials, including colorants, printed thereon (col. 3, lines 8-10). It would have been obvious to a person having ordinary skill in the art to print both sides of the webs of McFarland and Schleinz. The skilled artisan would have been motivated to print both sides of said webs by the desire to make both sides more attractive to consumers. The examiner takes official notice that if the process of Krzysik would not inherently result in the two inks being in register with each other, than it is extremely common and well known in the art to print images which are substantially in register. In support of this position the examiner notes the teachings of Schleinz (col. 3, lines 57-64) and those found in Fairchild's Dictionary of Textiles (p.190 and 466). It would have been obvious to the skilled artisan to print said images in register by the reasoned expectation of forming products, which are more attractive to consumers.

With respect to claim 4, it would have been an obvious matter of design choice to vary the thickness of the material being printed on, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ

237 (CCPA 1955). The skilled artisan would have been motivated to vary the thickness of the material by desire to conform said web to a variety of end use applications.

With respect to claims 5, 8-9, and 19, Schleinz teaches that it is well known in the art to print on nonwovens formed from polyester and cellulose. Similarly McFarland incorporates by reference about 17 patents, several of which teach nonwoven webs formed from a combination of polyester and cellulose. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use these materials in applicant's claimed amounts, since it has been held to be within the general skill of a worker in the art to select a know material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claims 6-7 and 18, it would have been well within the level of ordinary skill in the art to vary the density of said nonwoven webs in order to vary their absorbency characteristics, weight, and hand.

It would also have been will within the level or ordinary skill in the art to form said webs circular as an obvious matter of design choice.

With respect to claims 10-15, both McFarland and Schleinz list a wide variety of inks, which are suitable to be printed on the disclosed absorbent substrates. In fact, neither reference is limited to the use of any particular type of dye and both teach that virtually any pigments including organic, inorganic, and waxes may be practiced with the invention. It is therefore, the examiner's position that if inks of applicant's claimed ink categories are not inherently disclosed by McFarland and Schleinz then it would have been obvious to the skilled artisan to utilize said claimed categories. Inks conforming to

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certain government regulations would allow them to be sold in broader markets. Inks, which are non-leaching would make more durable products. Inks having certain viscosities would allow them to be more easily handled and applied.


Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pratt whose telephone number is 703-305-6559. The examiner can normally be reached on Monday - Friday from 7 am to 4 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.

Christopher C. Pratt
April 19, 2001


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700